Supreme Court, U.S.
FILED
MAR 5 1999
CLERK

No. 98-1244

In The

Supreme Court of the United States

October Term, 1998

WILLIAM BRADSHAW and ROBERT SHEPHERD,

Petitioners,

v.

IGLOO PRODUCTS CORPORATION,

Respondent.

On Petition For Writ Of Certiorari
To The United States Court Of Appeals
For The Federal Circuit

RESPONDENT'S BRIEF IN OPPOSITION

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LIST OF PARTIES AND PARENT COMPANIES

William Bradshaw

Robert Shepherd

Igloo Products Corporation

Brunswick Corporation,
the parent of Igloo Products Corporation

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STATEMENT OF THE CASE

A portable cooler on wheels, with lifting handles and a pulling handle coupled to the cooler by separate support axles, was not new when the petitioners, William Bradshaw and Robert Shepherd (hereinafter collectively "Bradshaw"), made the invention which became the subject matter of U.S. Patent No. 4,873,841 (hereinafter the "Bradshaw patent"). The prior art Mason U.S. Patent No. 4,846,493 illustrated and described precisely such a construction, as shown in FIGURE 4 of the drawings from the Mason patent, reproduced at page 1 of the Appendix to this Response.

The Bradshaw patent application was filed with fifteen claims which differed from the prior art only in that they literally required that both a lifting handle and a separate pulling handle be coupled to the same handle support axle on the end of the cooler opposite the wheels, as shown in FIGURE 1 of the drawings from the Bradshaw patent, reproduced at page 2 of the Appendix to this Response. The Bradshaw patent issued with those fifteen specifically limited claims.

In 1994 the respondent, Igloo Products Corporation (hereinafter "Igloo"), began manufacturing and selling a portable cooler which it called the Cool Roller. The Cool Roller product has a lifting handle and a separate pulling handle which are, like the Mason patent construction, coupled to separate handle support axles on the end of the cooler opposite a pair of wheels. Igloo designed its wheeled cooler with a lifting handle and a separate pulling handle attached to separate handle axles specifically to avoid the claims of the Bradshaw patent.

Bradshaw acknowledges that the patent claims do not literally cover the Igloo Cool Roller product. However, in an infringement action against Igloo, Bradshaw contended that the Cool Roller product infringes under the Doctrine of Equivalents.

In a motion for summary judgment of non-infringement, Igloo contended that Bradshaw could not rely upon the Doctrine of Equivalents to establish infringement. Igloo contended that prior art, including specifically the Mason patent, barred Bradshaw as a matter of law from relying on the Doctrine of Equivalents. The District Court concluded that Bradshaw could not rely on the Doctrine of Equivalents to establish infringement because the patent claims would be invalid over the prior art if two handle axles were considered the equivalent of the single handle axle claimed.

Bradshaw appealed to the Court of Appeals for the Federal Circuit (hereinafter the "Federal Circuit"). Bradshaw argued that the issue of whether the Igloo Cool Roller product infringed the Bradshaw patent claims under the Doctrine of Equivalents was entirely one of fact for the jury, *i.e.*, the District Court should not have been permitted to summarily decide that issue.

The Federal Circuit disagreed and affirmed the judgment of the District Court. The Federal Circuit decided that the District Court had reached the correct conclusion, but chose to affirm on grounds other than those relied upon by the District Court.

The Federal Circuit decided that where, as here, the patent claims at issue and the patent specification are clear in defining a critical element of the invention as a

single handle axle to which both a lifting handle and a pulling handle are coupled, that element is necessary to the claims as a matter of law. The Federal Circuit further concluded that the absence of this element from the Cool Roller product insulates the product from infringement under the all elements rule recited in *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931 (Fed. Cir. 1987) (in banc). Specifically, the Federal Circuit said that:

> "As we held in Bradshaw's previous appeal to this court, the patent is extremely clear that the pulling handle and the nearby lifting handle are both attached to the same axle. *See Bradshaw*, 1996 WL at **2. Specifically, our examination of claim 1 of the '841 patent reveals that Bradshaw disclosed a 'pulling handle coupled to one of the handle support axles.' There can be no doubt, then, that the pulling handle and one lifting handle must be attached to the same handle support axle. The language of claims 6 and 11 is equally precise. Moreover, the specification makes repeated reference to the fact that the pulling handle is attached to the same handle support axle as one of the lifting handles. *See, e.g.*, '841 pat., col. 1, II. 31032; col. 2, II. 63-64; col. 3, II. 1-3. Thus, one element of the '841 patent must be a handle support axle to which both a lifting handle and a pulling handle are attached. That element or limitation is entirely missing in the accused cooler and thus equivalent infringement fails under *Pennwalt*'s all-element or all-limitations rule. *See, Pennwalt*, 833 F.2d at 935, 4 USPQ2d at 1740."

Bradshaw now contends in the Petition that the Federal Circuit panel which decided the case has violated the

dictates of that Court's majority by creating a new category of cases in which a patent can be denied a jury determination of equivalence. Bradshaw contends that there are only three judicially approved situations in which a jury determination of equivalence can be avoided as a matter of law: one, where the patent prosecution history estops the patentee from proving that a particular feature of the accused device is covered by a patent claim; two, where prior art limits the extent to which the literal language of claims can be hypothetically expanded to cover an accused device; and three, where the District Court makes a determination that no reasonable jury could find equivalence. In the present case, according to Bradshaw, the Federal Circuit panel has erred by making a factual determination that there was no equivalence "under the guise of applying an alternative rule of law," *i.e.*, a rule of law other than one of the aforedescribed three.

To remedy this perceived error, Bradshaw petitions this Court to instruct the Federal Circuit that the "equivalence" issue, in its entirety, should be one of fact for a jury. This Court is thus asked by Bradshaw to take the step which it found unnecessary to take in *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 117 S. Ct. 1040 (1997), where it said (520 U.S. at 38):

> "whether, or how much of the application of the Doctrine of Equivalents can be resolved by the court is not necessary for us to answer."

As a policy based reason for this Court to grant their Petition, Bradshaw suggests that the twelve (12) judges of the Federal Circuit are divided on the issue of whether application of the Doctrine of Equivalents is for judge or

jury. Bradshaw further suggests that this Court's reluctance to decide the issue is creating uncertainty in a fundamental area of patent law. Finally, Bradshaw suggests that there is ample evidence for a jury to find infringement under the Doctrine of Equivalents in the present case.

ARGUMENT OPPOSING ALLOWANCE OF THE WRIT

I. THE PETITION SHOULD BE DENIED BECAUSE THERE IS NO VALIDITY TO BRADSHAW'S ARGUMENT THAT THE JUDGES OF THE FEDERAL CIRCUIT ARE IN DISARRAY ON THE ISSUE OF WHETHER APPLICATION OF THE DOCTRINE OF EQUIVALENTS IS FOR JUDGE OR JURY

The twelve judges of the Federal Circuit, sitting *in banc* in *Hilton Davis Chem. Co. v. Warner-Jenkinson Co., Inc.*, 62 F.3d 1512 (Fed. Cir. 1995), *rev'd and remanded*, 520 U.S. 17, 117 S. Ct. 1040 (1997), disagreed, seven (7) to five (5), regarding the extent to which the Doctrine of Equivalents determination should be for the fact finder or the Court. The seven judge majority concluded that the determination should be made in the same manner that it had been for many years, with a fact determination of gross equivalence if legal limitations did not bar the way. Four dissenting judges believed that the determination was entirely for the court, as a matter of equity. A fifth dissenting judge separated the determinations but called for element-by-element comparison.

The two issues are: whether the patentee is legally prevented from asserting infringement under the Doctrine of Equivalents and, if not, whether there is

structural and functional equivalence between the elements of a properly construed claim and an accused device. The former was, and is to this day, a question of law for a court. The latter was, and is to this day, a question of fact for the jury.

The three judges of the Federal Circuit who sat on the panel in the present case, Judges Rich, Michel and Clevenger, had all been in the *in banc* majority in the case below, *i.e.*, in *Hilton Davis Chem. Co. v. Warner-Jenkinson Co., supra*. Thus, when the panel decided the present case they were obviously very much in tune with that *in banc* majority. They decided unanimously that the fact question, *i.e.*, whether there was structural and functional equivalence between the elements of the Bradshaw patent claims and the accused Cool Roller product, was not reached in this case because the all-elements rule of law had been violated, whereby the Doctrine of Equivalents could not be relied upon to prove infringement. Thus, they decided this case in precisely the procedural manner approved by this Court. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co., supra*.

Bradshaw sought rehearing of the Federal Circuit decision. Bradshaw suggested that the rehearing be *in banc* to determine, as a matter of law, whether application of the all elements rule required a factual determination of equivalence as part of the analysis. The Federal Circuit denied the motion for rehearing.

Against this background, what the Bradshaw Petition appears to be arguing is that any Federal Circuit panel containing a majority of the dissenting judges from the *in*

banc minority in *Hilton Davis Chem. Co. v. Warner-Jenkinson Co., supra,* might decide a future case contrary to established rules for deciding Doctrine of Equivalents cases. How such a speculative decision could be made in light of this Court's opinion in *Warner-Jenkinson Co. v. Hilton Davis Chem. Co., supra,* and the Federal Circuit's denial of rehearing here is not clear, however. What is clear is that the panel in the present case and this Court are in concert on the proper way to handle Doctrine of Equivalents cases.

II. THE PETITION SHOULD BE DENIED BECAUSE THE ONLY ISSUE RAISED BY THIS CASE IS WHETHER THE CLAIMS HAVE BEEN PROPERLY CONSTRUED AS A MATTER OF LAW AND THERE IS NO UNCERTAINTY ENGENDERED AS TO HOW THE DOCTRINE OF EQUIVALENTS SHOULD BE APPLIED

In their Petition, Bradshaw recites the aforedescribed "three known rules of law under which a patent holder may be denied a jury determination of equivalence: prosecution history estoppel, prior art and a determination that no reasonable jury could find equivalents." However, a fourth rule of law under which a patent holder may be denied a jury determination of equivalence is ignored, the all elements or all limitations rule. In guidance offered by this Court in *Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co., supra,* 520 U.S. at 39, footnote 8, the all elements rule was approved as a court determined limitation on the right to a jury determination of equivalence. As noted there by this Court, if a theory of equivalence (between a patent claim construed as a matter of law and

an accused device) "would entirely vitiate a particular claim element," summary judgment should be rendered by the court.

Here the Federal Circuit concluded that the Doctrine of Equivalents "may not legally cover the accused . . . device" because the Bradshaw patent claim limitation requiring a single handle axle to which both a lifting handle and a pulling handle were coupled was "entirely missing in the accused" device. The Federal Circuit concluded that, in the context of the plain meaning of the claim language and the patent disclosure, the all elements rule was violated by the Bradshaw theory of infringement and that summary judgment of non-infringement was proper. The potential jury question of whether the elements of the Bradshaw patent claims each find equivalents in the accused Cool Roller product could not be reached because, as a matter of law, a legal restriction on the extent to which a patentee can avoid the definitional and public notice functions of the statutory claiming requirement had been violated.

Bradshaw disputes the validity of this legal conclusion by arguing that the Federal Circuit should not have relied upon the all elements rule to deny access to a jury because, in this particular case, a jury would find the missing element to be present in the accused device in another form. Citing *Ethicon Endo-Surgery, Inc. v. United States Surgical Corp.*, 47 U.S.P.Q.2d 1272, 1280 (Fed. Cir. 1998), Bradshaw argues that by its very nature the all elements rule requires a fact determination, and that there is no indication such a fact determination was made here, either by the District Court or by the Federal Circuit panel. According to Bradshaw, the Federal Circuit's

application of the all elements rule entirely eliminates the rule and, as a matter of law, directly contradicts its decision in *Ethicon* only three months earlier. Igloo submits that this argument is without merit.

In *Ethicon*, the failure by an accused device to literally meet a claim limitation under the facts of that case did not amount to "specific exclusion" of an element from a patent claim as a matter of law. *Id.* at p. 1277. The *Ethicon* panel noted that such a legal bar to equivalence did exist, however. The *Ethicon* panel cited *Athletic Alternatives, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573, 1582, 1583 (Fed. Cir. 1996), in which the Federal Circuit determined that under the all elements rule a patent claim may be legally construed to specifically exclude structure. Unlike *Ethicon*, under the circumstances of the present case the Federal Circuit panel determined as a matter of law that there had been a specific exclusion. Judges Michel and Clevenger from the panel in the present case sat on the *Athletic Alternatives* panel.

Thus, the issue raised by the Federal Circuit panel's decision in the present case is merely whether the panel properly construed claim language in the Bradshaw patent as a matter of law, not whether it encroached upon the jury's domain in a Doctrine of Equivalents determination. No uncertainty in the law is engendered by the decision of the panel in this case, regardless of whether its legal construction of the claims was correct or incorrect. Igloo submits that its construction of the claims was correct.

The Bradshaw Petition also argues that access to a jury cannot be denied here on grounds that no reasonable

jury could find equivalence, because neither the District Court nor the Federal Circuit had spoken on this subject. Since the Federal Circuit did not rely on this rule, however, the argument is not relevant.

III. THE PETITION SHOULD BE DENIED BECAUSE THE DECISION BELOW WAS CORRECT, AND WILL HAVE NO EFFECT OUTSIDE THE CONFINES OF THIS CASE

In support of the argument that sufficient evidence was present for a jury to find infringement under the Doctrine of Equivalents, Bradshaw paraphrases the Federal Circuit in *Sage Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420, 1424 (Fed. Cir. 1997). At page 16 of the Petition it is stated that "the doctrine of equivalents protects a patent holder from infringement where only minor or insubstantial charges have been made from a claimed invention while retaining its essential functionality." Bradshaw argues that such is the situation here.

Igloo submits, however, that the *Sage Products* decision is more in point for what the Federal Circuit stated later in the same opinion, *i.e.*, at 126 F.3d 1424 and 1425. Quoting from its own precedent, the Federal Circuit reiterated its position that the Doctrine of Equivalents cannot be used to erase meaningful structure and functional limitations of the claim on which the public is entitled to rely in avoiding infringement. It further stated that where no subtlety of language or complexity of technology, nor any subsequent change in the state of the art obfuscated the significance of a claim limitation at the time it was incorporated in a claim, it is the patentee and not the

public who must bear the cost of its failure to seek protection for a foreseeable alteration of its claimed structure. Otherwise, the patentee is allowed to file and prosecute narrow claims in the U.S. Patent and Trademark Office (PTO) and then, during the course of litigation, expand its claim to exclusive rights under the Doctrine of Equivalents and avoid PTO examination of the expanded claim. Bradshaw now seeks to do just that. The Federal Circuit panel in the present case properly employed the all elements rule to prevent this finesse.

Bradshaw contends Igloo stipulated that the Bradshaw patent and the Cool Roller products were mechanical equivalents. Igloo entered into no stipulation. Igloo merely stated in a brief that, solely for the purpose of the summary judgment motion argument being made, the Cool Roller product could be considered the mechanical equivalent of the Bradshaw patent cooler, *i.e.*, both are wheeled coolers with a pulling handle on the end opposite the wheels. But that is not even the issue which a jury would be faced with here. The jury here would be asked to consider whether individual elements of the two coolers were only insubstantially different, if they were not the same.

Bradshaw also argues its technical expert testified that elements of the Cool Roller products were the same as, or only insubstantially different from, the Bradshaw patent claim elements. However, Bradshaw fails to note that the District Court specifically found their expert to be one who was not skilled in the art relevant to this patent. As such, his testimony effectively carried no weight.

Finally, Bradshaw refers to deposition testimony from Igloo witnesses and affidavits from Igloo's customers. As with Igloo's alleged stipulation, however, this evidence fails to deal with the relevant fact issue.

CONCLUSION

The Federal Circuit panel in the present case adhered to rules approved by the Supreme Court in guidelines for applying the Doctrine of Equivalents. The decision of the panel is consistent with relevant Federal Circuit precedent and manifestly correct on the merits. It engenders no uncertainty in the law related to application of the Doctrine of Equivalents. Igloo respectfully submits that the Bradshaw Petition should be denied.

Dated: March 5, 1999

Respectfully submitted,

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